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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,143	09/12/2003	Joseph Gaikoski	P-B099	7743
29222	7590	07/07/2009	EXAMINER	
W. THOMAS TIMMONS			PLUCINSKI, JAMISUE A	
1320 PRUDENTIAL DRIVE			ART UNIT	PAPER NUMBER
SUITE 208			3629	
DALLAS, TX 75235-4117			MAIL DATE DELIVERY MODE	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/661,143	GAIKOSKI, JOSEPH	
	Examiner	Art Unit	
	JAMISUE A. PLUCINSKI	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 March 2009.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-39 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 7, 13, 19, 31, and 37-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Cinquini et al. (7,065,492).

3. With respect to Claims 7, 13, 19 and 31: Cinquini discloses a method and system for delivering items (See Abstract) of predetermined size and a maximum weight comprising:

- a. Pre-selecting delivery boxes, each selected of the proper size for an item of a predetermined size and predetermined weight (Reference numerals S110, S120, S210 and S220 with corresponding detailed description) due to the fact that the boxes are for a maximum weight and size, the examiner considers them to be pre-selected for an item with the a max weight and size;
- b. Providing a means for placing a delivery name and address on each box (Column 2, lines 44-57);

- c. Affixing a delivery indicia on each box of the proper denomination for the maximum weight and size, plus the weight of the box (Reference numerals S130 and S230 with corresponding detailed description, and Column 3, lines 53-57);
- d. Placing the item of the predetermined size and no more than the maximum weight into a box (Reference numerals S140 and S240 with corresponding detailed description);
- e. Closing the box (Column 4, lines 6-7);
- f. Placing the delivery name and address on the box (Reference numerals S150 and S250 with corresponding detailed description);
- g. Delivering the closed box to the carrier (Reference numerals S150 and S260 with corresponding detailed description, Cinquini discloses the box is delivered to a drop-off box, which is accessed by the carrier, therefore the examiner considers this to be delivered to the carrier, due to the fact that the carrier has access to it).

4. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987), *In re Paulsen*, 30F.3d1475, 31USPQ 2d1671 (Federal Circuit 1994). Therefore the system claiming the items are gifts or discs does not structurally affect the system as recited, therefore anticipated by Cinquini.

5. With respect to Claims 37, 38 and 39: Cinquini discloses the use of Delivery boxes for mailing items with pre-paid delivery based on the item and its weight (See Column 2, and abstract). It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art

apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987), *In re Paulsen*, 30F.3d1475, 31USPQ 2d1671 (Federal Circuit 1994). Therefore the system claiming the items are gifts or discs does not structurally affect the system as recited, therefore anticipated by Cinquini.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 8, 9, 14-15, 20, 21, 25-27, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cinquini (7, 065, 492).

8. With respect to Claims 1 and 25: Cinquini discloses a method for delivering items (See Abstract) of predetermined size and a maximum weight comprising:

h. Pre-selecting delivery boxes, each selected of the proper size for an item of a predetermined size and predetermined weight (Reference numerals S110, S120, S210 and S220 with corresponding detailed description) due to the fact that the boxes are for a maximum weight and size, the examiner considers them to be pre-selected for an item with the a max weight and size;

i. Providing means for placing a delivery name and address on each box (Column 2, lines 44-57);

- j. Affixing a delivery indicia on each box of the proper denomination for the maximum weight and size, plus the weight of the box (Reference numerals S130 and S230 with corresponding detailed description, and Column 3, lines 53-57);
- k. Placing the item of the predetermined size and no more than the maximum weight into a box (Reference numerals S140 and S240 with corresponding detailed description);
- l. Closing the box (Column 4, lines 6-7);
- m. Placing the delivery name and address on the box (Reference numerals S150 and S250 with corresponding detailed description);
- n. Delivering the closed box to the carrier (Reference numerals S150 and S260 with corresponding detailed description, Cinquini discloses the box is delivered to a drop-off box, which is accessed by the carrier, therefore the examiner considers this to be delivered to the carrier, due to the fact that the carrier has access to it).

9. Cinquini discloses the method being used for items, and fails to disclose the method being used for gifts or discs. However, the specific type of items is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The providing, affixing, placing, closing and delivering steps would be performed the same regardless of what type of items are placed in the box. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

10. With respect to Claims 2, 3, 8, 9, 14, 15, 20, 21, 26, 27, 32 and 33: Cinquini discloses the method and system being used for items which a user at an airport does not want to take through security and discloses the carrier can be a postal carrier, therefore the indicia being a postal

indicia (Column 3, line 64), however fails to disclose the items are compact discs or DVDs in jewel cases. However, the specific type of items is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The providing, affixing, placing, closing and delivering steps would be performed the same regardless of what type of items are placed in the box. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

11. Claims 4, 5, 10, 11, 16, 17, 22, 23, 28, 29, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cinquini in view of McClung et al. (US 2004/0059636).

12. With respect to Claims 4, 5, 10, 11, 16, 17, 22, 23, 28, 29, 34 and 35: Cinquini discloses the use of the carrier being USPS, UPS or FedEx as the carriers, the examiner considers these carriers to be freight carriers and ship carriers, due to the fact that all of these carriers ship internationally and ships packages all the way across the continent, therefore considered to be freight. Cinquini discloses the use of indicia being printed on the boxes, however fails to disclose the use of the indicia being applied to a waybill which is then affixed to the box. McClung discloses the use of a shipping service, which creates waybills containing carrier information (which the examiner considers to be indicia), and attaches them to the outside of boxes (See Paragraphs 0090-0094). The use of waybills having shipping information and packing information, which is then attached to the outside of packages being shipped, is old and well known in the art. This is done when ordering things remotely, such as over the internet, or large boxed items in warehouses, where reboxing the item to add a packaging slip is

burdensome, therefore the packing lip is attached to the outside of the original box. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to have the delivery indicia be applied to a waybill, and the waybill being attached to the box, as disclosed by McClung, and well known in the art, in order to provide shipping/delivery information along with the package, for larger items. (See McClung, pages 7 and 8) (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

13. Claims 6, 12, 18, 24, 30 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cinquini in view of Kara (US 2007/0198441).

14. With respect to Claims 6, 12, 18, 24, 30 and 36: Cinquini discloses the use of items being mailed in a box, however fails to disclose the box being quipped with a gift card which is attached to the box or included in the box. Kara discloses the use of a mailer, which can be purchased, which includes a gift card/message in the postal indicia area (See Figures 10-13 with corresponding detailed description). It would have been obvious to one of ordinary skill in the art to use the gift card/message of Kara, on the box of Cinquini, due to the fact that it allows the sender to add a personal message along with the item, and allows for the message to be printed along with the postal indicia and the address. Using the known technique of adding cards/messages of Kara to a box if Cinquini which is shipping an item would have been obvious to one of ordinary skill in the art. (See KSR [127 S Ct. at 1739] “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

Response to Arguments

15. Applicant's arguments filed 3/10/09 have been fully considered but they are not persuasive.
16. The applicant has amended the claims to have the step of selecting, be pre-selecting instead. However, in the claims, it never states how the boxes are pre-selected, what is involved in the pre-selecting and who is pre-selecting the boxes, therefore due to the fact that Cinquini's packages have a maximum weight and size, the examiner considers this to be pre-selected for an item with a weight and size of the package.
17. With respect to Applicant's argument that the Cinquini is a mix and match system and not a system of pre-selected boxed with pre-selected items to be shipped: Looking at the claims, the claims state pre-selecting a delivery box, and each box selected of the proper size for an item of a predetermined size. The claims do not state that the box is pre-selected based on the particular item, but merely selected based on a proper size for "a" gift of a predetermined size. It is obvious that when an envelope is chosen the item it is meant to hold must fit in it. Therefore due to the fact that Cinquini has different size envelopes, then it takes into account different sizes. The envelopes are not sold along with the gifts in the claim, and not packaged with the gifts. But simply claimed as selecting a box or pre-selecting a particular box. It should be pointed out, that mailers for particular items are old and well known in the art. This is done for photo mailers and compact disc mailers. Whereas Cinquini may have different reasons for sending the items, the claimed steps are still done the same. Cinquini still pre-selects delivery boxes which is the proper size for a gift of a pre-determined size.

18. With respect to Applicant's argument that It is not well known and obvious to make waybills out in advance for boxes. In shipping there are many ways to show delivery indicia, and in the present invention, the delivery indicia are printed on a waybill. The indicia which show the amount charged for shipping, is what is printed on the waybill in advance, not the waybill being filled out. Therefore as claimed, the person purchasing the box can still fill out or complete the waybill after the selection of the box. The only thing that is done prior to the selection of the box is the printing of the delivery indicia. Therefore, the official notice states that the use of waybills with printed delivery indicia on them is old and well known in the art. Cinquini discloses the delivery indicia pre-determined and pre-printed on the package, therefore the combination of what is old and well known in the art and Cinquini, would produce a waybill with a pre-printed delivery indicia on it.

19. With respect to Applicant's arguments that it is not old and well known to have the gift cards associated with the pre-selected delivery box: The claims however state "providing a gift card for enclosing in or attaching to the box". The term "providing" has been given the definition of making available. The claims do not state that the gift card is included in the box or even associated with the boxes prior to obtaining the box, but simply states that they are made available for the purpose of attaching to or putting in the box. What they are used for, whether they are put in the box or not is considered to be intended use, in the claim, the positive recitation is simply making them available, which is old and well known in the art.

20. The arguments are not considered to be persuasive, therefore the rejections stand as stated above.

Conclusion

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/
Primary Examiner, Art Unit 3629